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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER STRANGE, AARON N	
			ART UNIT 2153	PAPER NUMBER
			NOTIFICATION DATE 07/21/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

08/978,490

Applicant(s)

KAWAKAMI, ITARU

Examiner

AARON STRANGE

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/3/08 have been fully considered but they are not persuasive.
2. With regard to claim 26, and Applicant's assertion that Shachar does not teach a designation indicating whether the predetermined apparatus is a "WWW server, a FAX information apparatus, a computer, and a telephone number" (Remarks 14), the Examiner respectfully disagrees. Shachar does disclose this, as was clearly pointed out in the Office action of 1/7/2008, (§11). Applicant's has failed to present any arguments explaining how the language of the claims patentably distinguishes them from the cited prior art.
3. With further regard to claim 26, and Applicant's assertion that Shachar fails to disclose "any operation such as shown for example in steps S21-S24, and S27, and S28-S30 and S33 in which the designation indicates communication ... and then selected appropriate communication protocols" (Remarks 14), it is noted that none of the above limitations appear in the present claims. The only mention of communication protocols in the claims appears in dependent claims discussing the "information providing apparatus" (i.e., claim 38). Furthermore, the specification appears to provide support only for selection of computer protocols during communication with the

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computer, and contains no mention of selecting protocols for communicating with the other devices.

4. The Examiner would like to again recommend conducting an interview before filing a response to the present Office action. The claim language is very confusing and there appears to be a significant disagreement regarding the differences between the present claims and the Shachar reference. The Examiner feels that an interview would greatly help facilitate a mutual understanding of the respective positions of Applicant and the Examiner and help identify allowable subject matter and/or issues for appeal.

Claim Objections

5. Claims 37, 40 and 43 objected to because of the following informalities: There appears to be a typographical error "the WW server" in each of the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 26-29, 31-34, 36, 37, 39, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shachar et al. (US 5,764,736) in view of Official Notice.

8. With regard to claim 26, it is noted that the newly added limitation "wherein *when* the designation indicated the predetermined apparatus is the computer, a processing is carried out to communicate with the computer" is an optional limitation that need not be present in the prior art for the claim to be anticipated. The language of the claim does not require the designation to indicate that the predetermined apparatus is the computer, and if it does not, the "processing" step will not occur.

In the interest of expedited prosecution, this limitation has been rejected, but this limitation has not been given patentable weight and cannot form the basis for distinguishing the claim from the prior art. Claim 37 contains a similar limitation and has been treated in the same manner.

9. With regard to claim 26, Shachar discloses an information processing apparatus configured to process information described in a language usable for describing link destinations, said apparatus comprising:

a) a receiver configured to receive said information transmitted by an information providing apparatus (at least Col 13, Lines 10-12), said information including:

1) a telephone number assigned to a line connected to a predetermined apparatus (at least Col 9, Lines 47-56); and

2) a designation of a communication method defining communication with the predetermined apparatus (at least Col 11, Lines 15-29), the designation indicating whether the predetermined apparatus is any one of a WWW server (Logo tag), a FAX-information apparatus (Fax Number Tag), a computer [E-Mail Address tag (col. 9, ll. 43-46) or Service Tag (col. 11, ll. 15-29)], and a telephone apparatus (Phone Tag) (at least Col 9, Lines 34-61);

wherein the telephone number and the communication method designation are embedded in text using tags (service tag) in the language usable for describing link destinations (at least Col 11, Lines 15-19);

b) a display configured to display said information received by said receiver (at least Col 13, Lines 38-40 and Col 7, Lines 44-48);

c) a pointing device configured to specify a predetermined position in said information displayed on said display (at least Col 13, Lines 41-44 and Col 7, Lines 52-55);

e) a communication controller configured to determine whether the designation indicates the WWW server, the FAX-information apparatus, the computer, and the telephone apparatus, and to establish a communication link with the predetermined apparatus based on the designation and the telephone number, if said predetermined position specified by said pointing device is associated with said telephone number (at least Col 13, Line 61 to Col 14, Line 20);

wherein when the designation indicates the predetermined apparatus is the computer, a processing is carried out to communicate with the computer (when a tag is

selected an action is invoked to establish communication with the computer)(col. 10, ll. 59-60; col. 5, ll. 31-36 and 43-60) (*See also* col. 13, ll. 27-40 and col. 14, ll. 1-20 discussing establishment of a communications session via data and/or voice using the type of network address in the markup element).

Shachar fails to specifically disclose a link display portion configured to display a visible linked object if said predetermined position specified by said pointing device is associated with said telephone number (i.e. the cursor is changed into a finger indicating that the user may press a button) (Remarks, Page 10).

The Examiner takes Official Notice that displaying a different cursor when a mouse is hovering over a link is and displaying a mark next to the lowest charge product or service is old and well known in the art. Shachar discloses using a browser that permits selection of hyper-links (at least Col 9, Lines 4-16), which are known to change the cursor when a user passes over a link to inform the user that they may select the link.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the cursor when the user is hovered over a link.

10. With regard to claim 27, Shachar further discloses an estimated communication charge for a telephone call to communicate with said predetermined apparatus;

wherein said estimated communication charge is computed by said communication controller based on said utilized telephone number (at least Col 13, Lines 27-32). Displaying this in the confirmation window along with the number would

have been obvious since it would have assisted the user in determination whether to allow the connection to start.

11. With regard to claim 28, Shachar further discloses that said information is described in HTML (at least Col 7, Line 66 to Col 8, Line 5);

wherein said telephone number is described along with a telephone-number tag showing that what is described by said telephone number is a telephone line (at least Col 9, Lines 47-52); and

further comprising a recognition device that judges whether or not said telephone number is associated with said predetermined position based on said telephone number tag (tags are associated with buttons on the screen that are selected by the mouse)(at least Col 7, Lines 38-65 and Col 9, Lines 23-33).

12. With regard to claim 29, Shachar further discloses a telephone number selector configured to select one from a plurality of phone numbers in a case plural telephone numbers are associated with said predetermined position (at least Col 9, Lines 47-52).

13. With regard to claim 31, Shachar further discloses that, in a case an attempt made by said communication controller to establish a communication link connecting said information processing apparatus to said predetermined apparatus after cutting off a line connecting said information processing apparatus to said predetermined network ends in a failure, either an attempt to establish a communication link connecting said

information processing apparatus to said predetermined apparatus is again made or said communication link connecting said information processing apparatus to said predetermined network is re-established (data session is resumed)(at least Col 14, Lines 2-8).

14. With regard to claim 32, Shachar further discloses that, in a case said attempt made by said communication controller to establish a communication link connecting said information processing apparatus to said predetermined apparatus ends in a failure, said information apparatus is capable of selecting either processing to again make an attempt to establish a communication link connecting said information processing apparatus to said predetermined apparatus or processing to re-establish said communication link connecting said information processing apparatus to said predetermined network (device selects to resume data session) (at least Col 14, Lines 2-8).

15. Claims 33 and 34 are rejected under the same rationale as claims 26-32, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

16. With regard to claim 36, while the system disclosed by Shachar shows substantial features of the claimed invention (discussed above), it fails to disclose that

establishing a communication link includes transmitting an identification and password to the computer.

The Examiner takes Official Notice that transmitting an identification and password as part of establishing a network connection to a computer was old and well known in the art at the time the invention was made. Doing so prevents unauthorized users from obtaining access to the computer. Shachar teaches protecting the business cards from unauthorized access via passwords (col. 10, ll. 46-49), and requiring a password would have increases the security of the system by preventing unauthorized users who had obtained a business card from accessing the computer associated with it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require an identification and password when establishing a connection to the computer via a business card to ensure that unauthorized users could not gain access to the computer.

17. With regard to claim 37, Shachar suggests that when the designation indicates the predetermined apparatus is the WWW server (logo tag is selected), a processing is carried out to communicate with the WWW server (when a tag is selected an action is invoked to establish communication with the server)(col. 10, ll. 59-60; col. 5, ll. 31-36 and 43-60). Shachar discloses that the "Logo tag" is associated with a "web page".

The Examiner takes Official Notice that including a web page address as part of a business's contact information was old and well known in the art at the time the

invention was made. Shachar's disclosure of associating the Logo tag with a web page would have suggested to one of ordinary skill in the art that this tag could be used to link to a web page associated with the business and that activation of the tag would result in the user being connected to the web page.

18. Claims 39, 40, 42 and 43 are rejected under the same rationale as claims 36 and 37, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

19. Claims 30, 38, 41 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shachar et al. (US 5,764,736) in view of Official Notice further in view of Capps et al. (US 6,512,525).

20. With regard to claim 30, while the system disclosed by Shachar shows substantial features of the claimed invention (discussed above), it fails to disclose a number added configured to add an international prefix to the telephone number as needed.

Capps discloses a number adder configured to add a number required for international communication to a telephone number in a case a selected telephone number by said telephone number selector is a telephone number of a foreign country (dialing prefix is automatically adjusted based on worksite) (at least Col 17, Lines 30-

37). This would have been an advantageous addition to the system disclosed by Shachar since it would have ensured that international numbers are properly dialed when communications are attempted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically add the prefix of an international telephone number to ensure that it is properly dialed when a connection is attempted.

21. With regard to claim 38, Shachar further discloses that said information is communicated by the information providing apparatus that includes first and second communication modes, the first communication mode connecting to a server apparatus through the Internet (at least Col 10, Lines 35-49), the first communication mode being used to obtain the text using tags having the embedded telephone number and the communication method designation (at least Col 13, Lines 10-12), and the second communication mode connecting to a telephone apparatus only through a secured public telephone network with a protocol corresponding to the determined designation, by-passing the Internet (pure voice calls only travel through PSTN)(at least Col 13, Line 61 to Col 14, Line 20), by using the telephone number obtained in the first communication mode and using a same telephone line (at least Col 8, Lines 44-47); and collecting information associated with the cost of establishing a connection with each communication means (at least Col 13, Lines 27-32).

Shachar fails to specifically a confirmation window that displays a mark that is appended to a lowest charge telephone number and to display said telephone number

to confirm that a previously selected communication link with said predetermined apparatus shall be established.

Capps discloses a confirmation window configured to display said telephone number to confirm that a previously selected communication link with said predetermined apparatus shall be established (at least Col 17, Lines 4-26). This would have been an advantageous addition to the system disclosed by Shachar since it would have notified the user that a connection was going to be initiated to the telephone number, giving them the opportunity to stop the connection if it was unintentional. Shachar further discloses collecting information regarding the cost to establish a connection via each telephone number (at least Col 13, Lines 27-32), and it would have been advantageous to display this information in the confirmation window to inform the user of any costs they may incur by establishing the communication via the selected phone number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a confirmation window prior to connecting to the telephone number in order to inform the user when a link may be selected and to give the user the opportunity to verify that the connection was intended and give permission for its initiation, after reviewing any potential costs.

22. Claims 41 and 44 are rejected under the same rationale as claim 38, since they recite substantially identical subject matter. Any differences between the claims do not

result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153

/A. S./
Examiner, Art Unit 2153

